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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,366	11/27/2001	Michael Anfred Cornelius	EBID1100-1	9027
25548	7590	03/25/2005	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US, LLP 4365 EXECUTIVE DRIVE, SUITE 1100 SAN DIEGO, CA 92121-2133			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,366

Applicant(s)

CORNELIUS, MICHAEL ANFRED

Examiner

Dennis Ruhl

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1,3, are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

For claim 1, the examiner notes that there is a recitation directed to technology in the claim; however, it is not considered as sufficient to render the claim statutory. Claim 1 recites the "electronically posting" of descriptive information. This recited use of technology is considered to be a trivial and is not considered to fall within the technological arts. For claim 1, the act of electronically posting the information is just the displaying of data, which alone is not considered sufficient to render claim 1 statutory. The acts of receiving the information (can be by mail), maintaining a list (can

be on paper), and updating a bidding status (writing down the most recent highest bid) do not require or recite any technology and all of these acts can be done by hand. The only act of using technology is the posting of information, which involves no data manipulation and is not a meaningful use of the data. Claim 1 is not considered to be statutory.

For claim 3, the examiner notes that the use of a computer network has been claimed. The steps of receiving information and providing access do not amount to anything other than the receiving of the information and the posting of the information. No data manipulation is occurring and nothing is being changed from one state to another. The claimed "facilitating" step does not involve any use of technology because the scope of this term includes the posting of one's phone number (part of the received information) which facilitates communication by allowing a person to call you. The facilitating step involves no further manipulative step using technology. The only use of technology in this claim is the receiving and posting of information, which is not considered to be within the technological arts and is not considered statutory.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by eBay.com.

For claims 1,3, eBay.com was founded in 1995 and is a web site where a person can send information relating to an item or service for sale. eBay receives the descriptive information about the item or service for sale and electronically posts the descriptive information for potential bidders to view. The potential bidders are able to view the information and place a bid if they desire to do so. A list of parties with an intent to bid is maintained as claimed. This is the list of registered eBay users that must register to use the eBay service and place a bid. When bids are submitted for a given item/service, eBay will keep track of the bidders and who has the current highest bid. eBay updates the bidding status as claimed. With respect to the claim language reciting that the descriptive information is related to a construction project, this can be viewed in two manners as follows:

a) The language is non-functional descriptive material that does not serve as a limitation. The descriptive information simply describes what the item/service is that is being offered for sale. This is just descriptive information that is not being manipulated in any manner and is just data that is being displayed. The data stored by eBay is the same kind of data, it is descriptive data on the item or service being offered for sale. A recitation directed to the kind of descriptive data (a home project versus a baseball card) that is being displayed will not be a limitation that will patentably distinguish over eBay. *In re Gulack*, 217 USPQ 401 (CAFC 1983).

b) The language "descriptive information related to a construction project" is very broad language and really does not define much of anything. Almost anything can be considered "related to a construction project". This can be the sale of work tools by

an individual, or the sale of a bulldozer, or even the sale of a desk that can be used in a trailer on site at the construction project (project manager office). The language "related to a construction project" is so broad that anything can be considered related to a construction project in some way. Workers drink coffee at construction sites, so anything having to do with coffee can be considered related to a construction project. eBay satisfies what is claimed.

For claim 3, the facilitating communication step is satisfied by the fact that eBay requires the buyer to contact the seller in 3 days if you are the highest bidder. Communication is required.

For claim 2, the examiner considers the recited structure of the system to be inherent in eBay. The use of a server and a database are inherent in eBay, they are necessarily present. A server is required to manage/control the operations of the data and the database is required to be able to store data on customers and items for sale. The server of eBay does what is claimed functionally because eBay does exactly what is claimed. Information is posted, a list is maintained, and bidding status is updated as claimed. The language directed to the kind of data being stored (or posted) is non-functional descriptive material that does not serve as a limitation. *In re Gulack*, 217 USPQ 401 (CAFC 1983).

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by nationalcontractors.com.

For claims 1,3, Nationalcontractors.com is a web site that started in 1997 and

provided for the posting of available construction projects and viewing by potential bidders. Information was received that described construction projects. See the list of "Upcoming Projects" portion of the web page. The projects are posted electronically so that "prescreened contractors" can view the posted projects and place a bid on the job if they want to. A list of parties intending to bid is maintained as claimed because the contractors are "prescreened" ahead of time and are registered users of the website. The bidding status is updated as claimed because the system keeps track of the highest bid and who the highest bidder is.

For claim 3, the facilitating of communication of bids is satisfied by the fact that bids are taken between a contractor and a seller (i.e. interested parties).

For claim 2, the examiner considers the recited structure of the system to be inherent in nationalcontractors.com. The use of a server and a database are inherent in nationalcontractors.com, they are necessarily present. A server is required to manage/control the operations of the data and the database is required to be able to store data on contractors and the listed construction projects. The server of nationalcontractors.com does what is claimed functionally because nationalcontractors.com does exactly what is claimed. Information is posted, a list if maintained, and bidding status is updated as claimed.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Elliott (6446053), Thompson (6393410), Wares (20010044768), Shemesh (6847939), Barni et al. (6064981), Chou et al. (6035289), and Curelop et al.

(WO 01/11526) disclose auction types of systems or are related specifically to construction project systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DENNIS RUHL
PRIMARY EXAMINER